

## REMARKS

**Office action summary.** Claims 1-9 and 21-62 are under consideration.

Claims 47 and 49-55 are rejected for obviousness-type double patenting over claims 32 and 34-40 of U.S. Patent No. 6,723,383. Claims 1-9 and 21-62 are rejected for obviousness-type double patenting over claims 60, 62, 68-70, 80-91, 84, and 90-111 of U.S. Patent No. 6,936,316.

The above rejections are obviated by the amendments made in this response, and otherwise traversed.

Applicant thanks the Examiner for reconsidering and withdrawing the rejections over the prior art.

**Terminal disclaimer.** A terminal disclaimer over 6,723,383 is presented with this response, overcoming the obviousness-type double patenting rejection over that patent.

**Claim amendments.** Claims 42 and 57 are amended to make them conform more precisely to the claims which were restricted out in the parent. Claims 47 and 49 are amended to exclude the elected major species of the parent. Claim 48 is cancelled as superfluous in light of the amendment to claim 47.

**Obviousness-type double patenting rejection over 6,936,316.** There was unfortunately an error in the prior office action response. Applicants' counsel by mistake indicated that U.S. Patent No. 6,936,316 was applied for by the assignee of the present application. However, that patent is owned by a different entity and was **not** filed by the present assignee (see Exhibit A). For this reason, a terminal disclaimer is not possible at this time.

Applicant had cited *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991), for the view that an obviousness-type double patenting rejection requires a showing that the claims of the 6,936,316 patent are obvious over those of the present patent application as well as vice versa. The Examiner has taken the position that *Braat* does not apply because the claims of the present application do not "conform" with the restriction requirement in the parent, because extensions of time were taken in the parent, and because the present divisional was filed shortly before the parent issued rather than immediately after the restriction requirement was made final.

The Examiner's position with respect to *Braat* appears to be based on an unduly harsh understanding of what constitutes culpable behavior by an applicant.

(1) There was a restriction requirement in the parent, coupled with an election of species requirement. The applicant prosecuted in the parent claims directed at one of the supposedly

separate inventions identified in the parent restriction requirement, canceling other claims and leaving them to be prosecuted here. Surely no culpability can attach to accepting a restriction requirement imposed by the PTO.

(2) The applicant in the parent prosecuted claims addressed to only one of the broader species in the PTO's election of species requirement. Surely no culpability can attach to "going with the flow" in this fashion and making the Examiner's life easier by focusing claims on the elected species.

(3) Extensions of time were sought, but extensions of time are a normal practice among busy patent attorneys who find that the work required by their dockets exceed the available hours in their day.

(4) When the claims initially prosecuted had been allowed, the applicant filed the present divisional. No culpability can be attached to filing divisionals towards the end of the pendency of the parent. That is a completely normal practice among applicants.

(5) The present divisional contained claims to most of the inventive subject matter to which claims did not issue in the parent. There can be no question that this divisional was filed to pursue subject matter which the applicant was required to withdraw or cancel in the parent as consequence of either the restriction or election of species requirements. The one claim which the Examiner has pointed to as claiming elected subject matter elected in the parent, claim 47, has now been amended to not claim such subject matter.

(6) Furthermore, and most tellingly, the restriction requirement made in the parent was in essence reiterated here *and then withdrawn*. This strongly suggests that the PTO *erred* in making the restriction requirement in the parent against similar claims. That restriction requirement in the parent prevented a number of the claims currently prosecuted from being made in that application. Thus, the applicant was kept from making claims in the parent due to the *PTO error* of restricting his claims in the parent, not by culpable behavior on the applicant's part, and thus the two-way rule of *In re Braat* should apply here.

The injustice of not applying *Braat* here is manifest. The 6,936,316 patent was not the work of the present assignee, but of an independent entity over which the assignee had no control. (See Exhibit A, assignment record from PTO website.) As already noted, the applicant in the parent, faced with an erroneous restriction requirement and an election of species requirement, conformed to them. The applicant in the parent "went with the flow," was

cooperative, and simplified the Examiner's task there. This was done to facilitate prosecution and to make things go smoothly. It is very sad that this cooperative and helpful behavior is now being called culpable and resulting in the applicant being unable to get any protection at all for much of the subject matter which the applicant disclosed long ago and which was restricted out.

The injustice here is even greater because the 6,936,316 patent will expire much later than any patent issuing from the present application. Thus, the terminal disclaimer which is being demanded, and which the assignee is presently unable to give, would have no effect on patent term. Many cases say that the primary policy behind terminal disclaimers is to prevent unwarranted extension of the patent term.

The injustice of not applying *Braat* is particularly manifest with respect to claims 41-46 and 56-62. There can be no question that (1) those claims were restricted out in the parent, (2) the restriction requirement in the parent was likely erroneous given that a very similar requirement was *withdrawn* here, and (3) the applicant thus, due to this PTO error, had no possibility to prosecute those claims until the filing of the present divisional. *Braat* should therefore apply.

**Conclusion.** For the reasons stated above, it is respectfully requested that the double patenting rejection over 6,936,316 be withdrawn. If the Examiner would like to discuss the claims, please call the undersigned at (650) 251-7724 or e-mail at [IMRutenberg@mintz.com](mailto:IMRutenberg@mintz.com).

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Patent Assignment Abstract of Title

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**Total Assignments: 1**

**Patent #:** 6936316      **Issue Dt:** 08/30/2005      **Application #:** 10314855      **Filing Dt:** 12/09/2002

**Publication #:** US20040109958      **Pub Dt:** 06/10/2004

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**Title:** INK-JET RECORDING MEDIUM WITH AN OPAQUE OR SEMI-OPAQUE LAYER COATED THEREON,  
METHOD FOR RECORDING AN IMAGE, AND A RECORDED MEDIUM WITH AT LEAST ONE LAYER  
RENDERED CLEAR OR SEMI-OPAQUE

**Assignment: 1**

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**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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